REMARKS

Claims 1-25 and 34-47 are pending in the present application. Claims 26-33 and 48-51 were canceled. Claims 1-4, 6, 14, 19, 34 and 39-40 were amended. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 102, Anticipation

The Examiner has rejected Claims 1-51 under 35 U.S.C. § 102(e) as being anticipated by U. S. Patent Application Publication No. 2002/0111888, of Stanley et al. This rejection is respectfully traversed.

II.   Purpose of Applicants' Invention

Through their invention, Applicants sought to make a useful new resource available to assist taxpayers in preparing tax returns. More specifically, Applicants recognized that there could be great utility in furnishing a taxpayer with a third party vendor, to provide tax data collection and storage services. After a taxpayer subscribes to such services, the vendor notifies financial institutions associated with the taxpayer of the relationship between the vendor and the taxpayer. The vendor is referred to in the application as a financial recording service provider, and is referred to hereinafter, for convenience, as "FRSP".

The above teachings are found in Applicants' specification, such as at page 5, lines 16-20, page 12, lines 4-12 and page 10, lines 5-16, as follows:

> In the depicted example, financial recording service provider **104** represents a third party vendor which provides tax data collection and storage services to client taxpayers, such as client taxpayer at computer **110**.

> A financial recording service provider provides Doe with the service of accumulating his tax information and assisting in the preparation of his tax returns. Doe has subscribed to the financial recording service for the year, and the financial recording service provider (or optionally Doe, individually) has informed all of the financial institutions with which Doe has a relationship that the financial recording service provider is representing Doe (Steps **402, 404, 406**).

> The financial recording service provider notifies participating institutions that the client taxpayer is associated with the financial recording service provider

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and may transmit tax data to the financial recording service provider after participating institutions consummate transactions with the client taxpayer (Step 406). Optionally, the client taxpayer may notify participating institutions with which he or she does business. The participating institutions may transmit tax data after each transaction, after predefined time periods have elapsed or annually on a predetermined date. (Emphasis added)

The above teachings of Applicants, particularly at page 12, lines 8-11, show that after establishing a relationship between a taxpayer and a FRSP, certain financial institutions may transmit tax related data to the FRSP. Particular tax data pertains to or results from a transaction consummated between one of the institutions and the taxpayer. As taught at page 12, lines 13-14, the tax data may be transmitted to the FRSP right after the corresponding transaction has occurred.

Thus, the FRSP may be used as a repository, to store tax related data for a taxpayer that is received over a period of time. For example, the FRSP could receive tax related information resulting from transactions of a taxpayer during an entire fiscal year. Then, after the fiscal year ended, all the tax data would be available from a single source, for use in preparing a tax return for the fiscal year. These teachings of Applicants are emphasized, for example, at page 12, lines 13-28 and also page 13, lines 11-15:

> During the year, financial transactions with tax implications occur involving John (Step 408). The participating institutions inform Doe of the transactions, if he is not party to the transactions directly, (e.g. posting of interest to a bank account, posting of capital gains to a mutual fund) (Step 410). When the transactions involve an institution participating in the financial recording service program, that institution also transmits information about the financial transaction to the financial recording service provider. For example, when a quarterly dividend is posted, the amount of the dividend and the taxpayer ID involved is sent to the financial recording service provider. Optionally, all of the participating institutional data may be sent once a year before taxes are due.

> One of the novel aspects of the invention herein disclosed is that in the inventive system disclosed herein such "seeding" is done with current year data, rather than the previous year's data as in existing tax preparation systems.

In view of the teachings discussed above, Applicants have amended Claim 1 to read as follows:

1.   A method of preparing a tax return comprising the steps of:
        authorizing a financial recording service provider to receive tax data resulting from transactions between a client taxpayer and one or more specified financial institutions, wherein each of said transactions occurs during a subsequent time period beginning after said authorization has been provided;
        transmitting said tax data resulting from transactions between said taxpayer and a given one of said financial institutions directly from said given institution to said financial recording service provider;
        storing all of said transmitted tax data under the control of said financial recording service provider; and
        sending all of said tax data from said financial recording service provider to a tax return preparer, for use in preparing a tax return for said taxpayer, after the end of said time period.

III.   Rejection of Claims 1, 14 and 34

The Examiner stated the following in rejecting Claims 1, 14 and 34:

        Re claims 1, 14, and 34, Stanley teaches preparing a tax return (abstract) comprising the steps of: subscribing to a financial recording service provider (para.0013); receiving tax data from the financial recording service provider and validating the tax data received from the financial recording service provider (para.0014); and, submitting the validated tax data (para.0017). In other words, Stanley discloses automated tax return preparation. The taxpayer is interviewed and his information is collected from financial institutions. Overall, Stanley's application enables an automated tax return system to prepare tax returns in advance with minimal user assistance.

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Respective paragraphs of Stanley cited by the Examiner, together with paragraphs [0011], [0012] and [0015] are as follows:

(57)   ABSTRACT

Automated tax return preparation is provided using a relationship-based interview process coupled with universal data import. Information is collected through a process called the interview, during which a taxpayer is asked various questions about her background and relationships with financial institutions. The taxpayer provides to the tax planning software a list of financial institutions with which the taxpayer has a relationship, and the tax software retrieves tax data directly from the financial institutions. The combination of the interview, universal data import, and existing stored data enables an automated tax return system to prepare tax returns in advance with minimal user assistance.

[0011] Referring now to FIG. 1, there is shown an illustration of a conventional method of tax return preparation using tax preparation software. At the beginning of the interview 101, the user has the opportunity to import data 102. This is typically an all-or-nothing type import, e.g. import all available data from Quicken, or none at all. Once data has been imported, the forms-based interview 104 begins. First, the taxpayer is asked to define 106 his status, e.g. single, married filing jointly, etc. Next, the taxpayer uses his W2 116 to enter information about his wages 108. Similarly, Form 1099 118 contains information the user must enter for the income section 110, and other forms such as Schedule K-1 must also be entered where necessary. The user also enters information about itemized deductions 112, etc. All of this information must be manually entered by the user. Finally, the conventional process ends with the software preparing a tax return document 114.

SUMMARY

[0012] In accordance with the present invention, there is provided a system and method for automated tax return preparation, using a relationship-based interview process coupled with universal data import (UDI).

[0013] A taxpayer maintains a plurality of relationships with a plurality of financial institutions. A financial institution is any entity that provides tax information about taxpayers, and a taxpayer has a relationship with a financial institution if the financial institution provides tax data about that taxpayer. The present invention includes an interview process that solicits data from the taxpayer by inquiring about the taxpayer's relationships with financial institutions, and not merely asking forms-based questions that simply track the layout of IRS tax forms.

[0014] There are many ways in which taxpayers can receive tax data. For example, in one embodiment, the taxpayer provides to the tax planning software a list of financial institutions with which she has a relationship, and the tax software retrieves information directly from the financial institution. In one embodiment, the taxpayer selects the financial institutions from a list provided by the software. In alternative embodiments, the taxpayer provides unique identifying information about the financial institution, such as an employer identification number (EIN), in the case of a payroll provider, or such other equivalent identifiers as may be appropriate for different types of financial institutions. The tax planning software determines whether the financial institution associated with the identifying information is able to provide tax data related to the taxpayer. If so, then the tax planning software retrieves that data and uses it to prepare a tax return.

[0015] Data is imported using universal data import. UDI enables the seamless import of tax data from a variety of import sources into tax preparation software. Import sources include financial institutions, financial management software

programs, other tax preparation software, and the like. In one embodiment, data to be imported is provided by the import sources in the format of an inherent data structure. A forms mapping language maps the data of the inherent data structure to various forms and fields in order to prepare a taxpayer's return. Imported data is checked automatically for completeness, and in one embodiment, only data that is missing or incomplete is flagged for the user's attention before an initial tax return is prepared. UDI enables a just-in-time style import whereby data can be imported throughout the interview by connecting to financial institutions on an as-needed basis to obtain the data, instead of only at the beginning or end of the tax preparation process. (Emphasis added)

[0017] The availability of taxpayer data through UDI and the stored taxpayer responses gathered during the interview process enable the present invention to provide for the automatic preparation of tax returns on an ongoing basis. In one embodiment, tax data is automatically imported from financial institutions and an initial return is prepared without user intervention. The taxpayer is notified that an initial return is available for review, and the taxpayer then accesses the prepared return and makes any necessary changes before filing the return with a tax authority.

Paragraph [0011] of Stanley discusses a prior art software approach for tax preparation. In this approach, a user manually enters available tax information, from his W2 and other available forms. Paragraph [0012] states an intent to provide a more automated system for tax return preparation.

IV.   **Response to Rejection of Claims 1, 14 and 34**

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F .2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 21 U.S.P.Q.2d 1031, 1034 (Fed Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. Kalman v. Kimberly-Clark Corp., 713 F .2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

Applicants respectfully submit that Stanley does not teach every element of the claimed invention, arranged as they are in Claim 1. Specifically, Stanley does not teach, in the over-all

from transactions between a taxpayer and financial institutions, wherein each transaction occurs during a time period that begins after the authorization. Morever, Stanley fails to disclose the Claim 1 teaching that tax data, for transactions occurring during the time period, is transmitted directly from respective institutions to the FRSP.

It is a fundamental principle of patent law that prior art must be considered in its entirety. MPEP 2141.02. Paragraphs [0013] and [0014] of Stanley disclose that the procedure thereof begins with an interview process driven by Stanley's tax preparation software. During the interview a taxpayer provides a list of financial institutions. Thereupon, the software determines whether an institution is able to provide related tax data, and if so, it then retrieves the data from the institution. Thus, Stanley teaches that tax related data is retrieved during the interview, as soon as the taxpayer provides the list of institutions and the software makes its determination. It will be readily apparent that in this scheme for retrieving data, the tax data must already exist, at the time that the interview occurs. Accordingly, these teachings of Stanley direct away from the recitation of Applicants' Claim 1, wherein tax data results from transactions that occur only during a subsequent time period, that begins after FRSP authorization.

The above teachings of Stanley are reinforced by paragraph [0015], which states explicitly that data can be imported throughout the interview, by connecting to the financial institutions. Clearly, Stanley anticipates that tax data will exist at the time of interview. Thus, this statement from paragraph [0015] likewise teaches away from Applicants' Claim 1 feature of receiving tax related data resulting from future transactions, during a subsequent time period.

The above teaching, that tax preparation in the Stanley arrangement is only concerned with currently existing tax data, is emphasized repeatedly in the Stanley disclosures. Further examples of this teaching are set forth at paragraphs [0031], [0054] and [0070], shown below:

> [0031] Referring now to FIG. 3, there is shown an overview of a process for preparing a tax return in accordance with the present invention. The interview begins 301 in a preferred embodiment not with an all-or-nothing style of import, but by asking questions about the taxpayer's status 306, e.g. "Are you married," in order to determine what kind of return should be prepared. Stored data 302 is imported via UDI 206, so that the taxpayer can rely on information already stored elsewhere, e.g. in Quicken. Next, rather than asking the user for his W2 information, she is asked to identify her employer. Using UDI 206, this allows W2 information to be automatically downloaded from the user's employer or payroll provider 304. Similarly, the user enters basic information about her financial accounts 310, e.g. where she has a bank or brokerage account, and Form 1099

information is automatically obtained from the bank or brokerage house 306. Next, the user is asked whether certain events have taken place during the year 312, e.g. "did you move your primary residence this year?" The answers to these questions are mapped to appropriate parts of the user's tax return, e.g. Schedule A (Itemized Deductions), as needed. Finally, a tax return 314 is prepared based on the user's answers during the interview and the imported data. (Emphasis added)

[0054] Next, and referring now to FIG. 7, the user provides identification information in order to retrieve importable data from import source 410. In order to ensure privacy and security, in one embodiment the user is required to provide